



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,349	08/16/2001	Byung Ju Dan	2080-3-33	2633
35884 7590 11/09/2007 LEE, HONG, DEGERMAN, KANG & SCHMADEKA 660 S. FIGUEROA STREET Suite 2300 LOS ANGELES, CA 90017			EXAMINER BEKERMANN, MICHAEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 11/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/931,349

Applicant(s)

DAN ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to papers filed on 8/31/2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 35-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 35 & 42 recite limitations referring to a toy having a body with body parts, and further limitations referring to those body parts "grow[ing] in dimension". Claim 42 also refers to "generating expressions". None of this information was disclosed in the original filing.

2. **Claims 38 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. While it is easy to see how a virtual character could grow, it is

unclear as to how the toy can physically grow and this lacks an enabling explanation. It appears that applicant is attempting to claim physical growth, and while the specification recites the term "physically" when referring to growth, the specification does not have any description of how this growth could occur. In fact, the specification recites the toy as being intellectually grown (storing more information) as well. Thus, Examiner interprets the word "physically" to refer to visual growth of a virtual character as opposed to the intellectual growth, which is not visual. Since a virtual pet could "physically" grow, as in the virtual body of the pet "physically" growing in size on the display screen, and in light of the lack of enablement, Examiner interprets the toy growing in size (as recited in claim 38) to refer to the visual growth of the virtual character, and not to the growing of the outer casing of the toy.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 35, 39, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claims 35 and 42, these claims recite the limitations "associated with desires of a living organism" and "associated with an animal's natural desires". This is indefinite and unclear. What does a living organism desire? Not all living organisms desire the same thing. For example, many sea creatures desire to remain underwater, never coming up for air. The Examiner, however, as a living organism,

does not desire this. Under the broad meaning of “desires of a living organism”, is the desire to remain underwater indefinitely to be included or excluded by the claim language? If applicant replaces the “living organism” language with a Markush listing examples supported by the specification, this would appear to overcome this rejection.

Referring to claims 35 and 42, these claims recite the limitation “information that satisfy the first desire”. It is unclear as to what information this refers. One person may require one sandwich to satisfy a desire for hunger while another person may desire a sandwich and a bag of chips. Satisfaction of a desire is obtained differently for each living organism. As in the previous example, if the desire is to remain underwater indefinitely, does a fish tank (or an advertisement for one) satisfy this desire? Does a swimming pool? Is the water alone enough to satisfy the desire? Would products or services meant to acquire a goldfish’s satisfaction be enough to satisfy a whale? Perhaps adding language states the goods or services information is programmed to satisfy the desire would better clarify the claim.

Referring to claim 39, this claim recites the limitation “associated with emotions of a living organism”. This is indefinite and unclear. What emotions does a living organism have? Does a single-celled organism have emotions? If this question can’t even be answered, then the indefinite nature of the claim is made even worse.

Referring to claim 42, this claim recites the limitation “at least one of the body parts grows in dimension”. It is unclear how this type of limitation can be implemented in the real world while referring to something that is a non-living object. While looking at the specification, no indication was even hinted at for how this could be done.

Response to Arguments

4. Applicant argues that the new matter objection was improper because no new matter was introduced into the specification. Applicant further points out that the proper way to address new matter introduced into the amendments was to apply a 112 1st paragraph rejection. Examiner selected the wrong form paragraph and thanks Applicant for catching this error and bringing it to the Examiner's attention. Examiner has corrected the action above with the corrected form paragraph. Applicant's response and arguments indicate that there was a full understanding of the new matter issues present in the current claims regardless of the new matter issues being cited as an objection versus a rejection. Thus, this action is made final.

5. Applicant argues "one of ordinary skill would understand that a toy can physically grow in size by way of a mechanical instrument incorporated in one of the toy's physical limbs, elements, or attributes". Examiner notes that in the figures 10-12, there are 3 renditions of the toy in question. The toy appears to be an egg-shaped device with a screen. There appear to be 4 lines coming from the device with a circle at the end of each line. These are no reference numerals assigned to these circles. Examiner does not consider this to be a teaching of an appendage or body part. Even assuming that these figures do indeed show body parts (Examiner would like to restate that there is no text in the specification that could be used as evidence to back this argument), between the figures 10-12 no growth of these "body parts" is shown. In fact, throughout the specification there is no indication that the egg-shaped device has "body parts" or that

Art Unit: 3622

those body parts would grow. If the egg-shaped device in the figures had limbs that grow, this should have been stated in the specification and the figures labeled as such. Applicant currently has support for a virtual character that interacts and grows through the display on the egg-shaped device, but there is no support for a growing egg-shaped device.

6. Applicant further argues that the examples given regarding the 112 rejections over "desires of living organisms" and "emotions of living organisms" are difficult to follow and do not apply to supportive language under Section 112. Examiner has not provided these examples in an attempt to be overly vague. These examples are to show that "desires of a living organism" and "emotions of a living organism" are not clearly defined terms. Examiner will provide one more example. Is "envy" a desire or an emotion? One person might say it is a desire (to envy something). Another might say it is an emotion (someone can be envious). A third person might say it is both and a fourth person could potentially say "envy" is neither. Should a person reading the specification of the current application be required to call Applicant to find out which interpretation the Applicant follows? These questions (and the ones in the examples above) should not have to be raised when reviewing the claims of an application.

Allowable Subject Matter

7. Claims 35-42 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 1st and 2nd paragraphs set forth in this Office action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

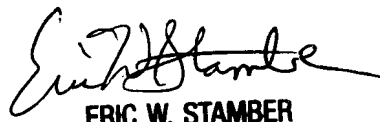
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB


ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600